UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/707,582	12/22/2003	James A. Euchner	F-629	1581

919   7590   05/04/2006

PITNEY BOWES INC.
35 WATERVIEW DRIVE
P.O. BOX 3000
MSC 26-22
SHELTON, CT 06484-8000

EXAMINER
FABER, DAVID

ART UNIT	PAPER NUMBER
2178	

DATE MAILED: 05/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	10/707,582	EUCHNER ET AL.
	Examiner	Art Unit	
	David Faber	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>03 March 2006</u>.

2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-5 and 7-21</u> is/are pending in the application.

    4a) Of the above claim(s) <u>6</u> is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-5 and 7-21</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

1.   This office action is in response to the amendment filed 3 March 2006.

2.   In this amendment, Claims 1, 7, 9-13, and 20 have been amended. Claim 6 has

been cancelled by the Applicant. Claim 21 has been added to the claims.

3.   The rejection of Claims 1, 11, and 13 under 35 U.S.C. 103(a) as being

unpatentable over Kardach (US PG Pub 20030001020, filed 6/27/2001) has been

withdrawn necessitated by the amendment. The rejection of Claims 2-4, 12, and 14-16

under 35 U.S.C. 103(a) as being unpatentable over Kardach (US PG Pub

20030001020, filed 6/27/2001) in further view of Kuruoglu et al (PG Pub 20020078088,

published 6/20/2002) has been withdrawn necessitated by the amendment. The

rejection of Claims 5-6, and 17 under 35 U.S.C. 103(a) as being unpatentable over

Kardach (US PG Pub 20030001020, filed 6/27/2001) in further view of Bargeron et al

(PG Pub 20040205545, filed 4/10/2002) has been withdrawn necessitated by the

amendment. The rejection of Claims 7, 9 and 18 under 35 U.S.C. 103(a) as being

unpatentable over Kardach (US PG Pub 20030001020, filed 6/27/2001) in further view

of Ericson et al (PG Pub 20020054778, filed 5/9/2002) has been withdrawn

necessitated by the amendment. The rejection of Claims 8, 10, and 19-20 under 35

U.S.C. 103(a) as being unpatentable over Kardach (US PG Pub 20030001020, filed

6/27/2001) in further view of Ericson et al (PG Pub 20040205545, filed 4/10/2002) in

further view of Anderson et al (US Patent #5,581,682, patented 12/3/1996) has been

withdrawn necessitated by the amendment The rejection of Claims 10 and 20 under 35

U.S.C. 112, second paragraph has been withdrawn necessitated by the amendment.

4.   Claims 1-5, and 7-21 are pending. Claims 1, 13, and 21 are independent Claims.

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6.   Claims 1-5, 7, 9, 13-18, and 21 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Ericson et al (US PG Pub 20020054778, published 5/9/2002) in

further view of Kuruoglu et al (PG Pub 20020078088, published 6/20/2002) in further

view of Lortz (US PGPub 2002/0169986, published 11/14/2002).

As per independent Claim 1, Ericson et al discloses a method comprising:

- obtaining an original document; (Paragraph 0078,0079: author creates a new

  document, and sends the document to reviewers for reviewing.)

- making an original electronic version of the document available to an

  annotation manager system; (Paragraph 0077, 0078: Document is register

  with the central unit wherein the central unit registers the document and will

  update the document when the central unit receives the edits (Paragraph

  0081)

- associating the original electronic version of the document with digital paper; (Paragraph 0080, lines 1-5: Document printed on a printout on digital paper, wherein this paper contains positioning-coding patterns (FIG 1, Paragraphs 0019, 0025-0027).

- receiving a plurality of annotations from a plurality of team members each using a hardcopy of the original electronic version of the document that was printed on the associated digital paper; (Paragraph 0080, 0081: Discloses reviewers submitting edits/annotations to a central unit wherein the author can obtain the edits/annotations to be incorporated into the original electronic document)

- determining for each annotation if such annotation if such annotation is an authorized annotation (Ericson et al discloses that the author has the ability to select and approve each annotation before inserting it into the document (Paragraph 0087), thus authorization an annotation)

- associating each authorized annotation with a location in the original electronic version of the document; (Paragraph 0080-0081, 0086, 0088: annotations are sent and synch with the original document based on where the written annotation took place. Ericson et al discloses that the author has the ability to select and approve each annotation before inserting it into the document (Paragraph 0087), thus authorization an annotation)

- creating a new annotated version of the original electronic version of the document incorporating the authorized annotations. (Paragraph 0081, 0083, 0086): After it been translated, the editing information is incorporated into the electronic document to be displayed to the author, which produces an updated document based on the received editing information. Ericson et al discloses that the author has the ability to select and approve each annotation before inserting it into the document (Paragraph 0087), thus authorization an annotation)

Ericson et al fails to specifically disclose receiving annotation author identification data for identifying associating each of the plurality of annotations with the team member who created the annotation. However, Kuruoglu et al discloses receives a plurality of annotations from a plurality of team members using a hardcopy of the original document. (Paragraph 0027-0029, 0033-0035). In addition, Kuruoglu et al discloses that each annotation transferred to the server contains author identification data that identifies the author of the annotation. (Paragraph 0032)

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have combined Kardach with Kuruoglu et al since Kuruoglu et al provided the benefit of a real-time collaborative annotation system that enabling editors to edit documents regardless of being located at different locations.

In addition, Ericson et al and Kuruoglu et al fail to specifically disclose obtaining hierarchal permission data for each team member and using hierarchal data. However, Lortz discloses the use of authorization credentials and authorization level system. The

authorization level consists of four level, in a hierarchal way, of owner, editor, reviewer and none. The Owner permits complete administrative access to the resource, with the Editor permits read/write access, with the Reviewer permits read access and None is denied all accesses. (Paragraph 0020) Thus, a user with the Owner or Editor level would be allowed to write to the document with annotations while a user with a Reviewer or None level wouldn't be able to. In addition, the user's authorization credentials can be obtained by each client (team member) by generating an authentication request to the server for authorization that includes name and password of the client. (Paragraph 0009-0011) In conjunction with Ericson et al method of the author approving each annotation, the author would have an Owner allowing which annotations are to be permanently added.

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have combined Ericson and Kuruoglu et al with Lortz since Lortz would have provided the benefit of security that limits the accessibility and functionality in a collaborative system allowing only authorized users to edit documents.

As per dependent Claims 2-4, Ericson et al fails to specifically disclose the method further comprising incorporating annotation metadata into new annotation version, wherein the metadata includes a time and date associated with each annotation, and includes a user identification for each association. However, Kuruoglu et al discloses that each annotation is stored in the form of an object wherein comprises a document identifier, a location identifier, a time stamp indicating time and date the

annotation was detected, and author identifier identifying the author of the annotation.

(FIG 3; Paragraph 0032)

It would have been obvious to one of ordinary skill in the art at the time of

applicant's invention to have combined Ericson et al's method with Kuruoglu et al

method since Kuruoglu et al's method would have allowed the annotations to be

independently manipulated by being separated into objects.

As per dependent Claims 5, Ericson et al disclose the anchoring at least one of

the annotations to a paragraph of the original electronic version of the document.

(Paragraph 0088: overlaid handwritten comments (annotations) are maintained in synch

with their original position, whereby known as anchoring the annotation to the text.

As per dependent Claims 7, and 9, Ericson et al disclose parsing the annotations

for at least one editing commands, in which at least one of the editing commands is a

plurality of editing commands, and including prioritizing the editing commands. (Ericson

et al discloses recognizing a plurality of editing symbols, parsing each of the symbols,

and prioritizing the symbols by interpreting each symbol in a specific order into an

editing command to occur when annotating the document (FIG 5(a-c); Paragraphs

0070-73) in which Ericson et al discloses an embodiment wherein the editing

commands are received from multiple reviewer using the editing symbols technique

(Paragraph 0079-0080) In addition, in the conjunction of Lortz's authorization level, and

the rationale incorporated within, Lortz's authorization level and credentials of a client

user (team member) can be implemented with Ericson et al prioritizing the editing

commands thus only allowing editing commands to be processed from users with the correct authorization credentials..

As per independent Claim 13, Claim 13 recites a system for performing the method of Claim 1 and is similarly rejected under rationale.

As per dependent Claim 14, the applicant recites a system for performing the method of Claim 2 and is similarly rejected under rationale.

As per dependent Claim 15, the applicant recites a system for performing the method of Claim 3 and is similarly rejected under rationale.

As per dependent Claim 16, the applicant recites a system for performing the method of Claim 4 and is similarly rejected under rationale.

As per dependent Claim 17, the applicant recites a system for performing the method of Claim 5 and is similarly rejected under rationale.

As per dependent Claim 18, the applicant recites a system for performing the method of Claim 7 and is similarly rejected under rationale.

As per independent Claim 21, Ericson et al discloses a method comprising:

- creating a new annotated version of the original electronic version of the document incorporating the non-overlapping annotations. (Paragraph 0081, 0083, 0086): After it been translated, the editing information is incorporated into the electronic document to be displayed to the author, which produces an updated document based on the received editing information.)

In addition, Ericson et al discloses that the author has the ability to select and approve each annotation before inserting it into the document (Paragraph 0087); however, Ericson et al fails to specifically disclose receiving annotation author identification data for identifying associating each of the plurality of annotations with the team member who created the annotation, determining if any two of the annotations overlap, and if so, selecting one of the two overlapping annotations using the hierarchal data; creating a new annotated version of the original electronic version of the document incorporating selected overlapping annotations. However, Kuruoglu et al discloses that each annotation transferred to the server contains author identification data that identifies the author of the annotation. (Paragraph 0032) In addition, Kuruoglu et al discloses the ability to each annotation in a different color that can distinguished overlap among annotations in which the user would be able to determine if two annotations overlap. Furthermore, a user would be able to select a displayed annotation, overlapped or not, such as the ones shown on FIG 5. (Paragraph 0036-0037) Thus, in conjunction with Ericson et al, the author would be able to approve a selected overlapping annotation to be incorporated into the document if the author decides so.

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have combined Ericson et al with Kuruoglu et al since Kuruoglu et al provided the benefit of a real-time collaborative annotation system that enabling editors to edit documents regardless of being located at different locations, and the ability to distinguish each editor's annotations.

In addition, Ericson et al and Kuruoglu et al fail to specifically disclose obtaining hierarchal permission data for each team member and using hierarchal data. However, Lortz discloses the use of authorization credentials and authorization level system. The authorization level consists of four level, in a hierarchal way, of owner, editor, reviewer and none. The Owner permits complete administrative access to the resource, with the Editor permits read/write access, with the Reviewer permits read access and None is denied all accesses. (Paragraph 0020) Thus, a user with the Owner or Editor level would be allowed to write to the document with annotations while a user with a Reviewer or None level wouldn't be able to. In addition, the user's authorization credentials can be obtained by each client (team member) by generating an authentication request to the server for authorization that includes name and password of the client. (Paragraph 0009-0011) In conjunction with Ericson et al method of the author approving each annotation, the author would have an Owner allowing which annotations are to be permanently added.

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have combined Ericson and Kuruoglu et al with Lortz since Lortz would have provided the benefit of security that limits the accessibility and functionality in a collaborative system allowing only authorized users to edit documents.

7.   Claims 8, 10, and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ericson et al (PG Pub 2002/0054778, filed 5/9/2002) in further view of Kuruoglu et al (PG Pub 20020078088, published 6/20/2002) in further view of Lortz

(US PGPub 2002/0169986, published 11/14/2002) in further view of Anderson et al (US Patent #5,581,682, patented 12/3/1996).

As per dependent Claims 8, and 10, Ericson et al disclose converting non-priority editing commands into annotations. (FIG 5(a-c); Paragraphs 0070-73: discloses recognizing a plurality of editing symbols, and converting each of the editing symbols by interpreting each symbol in a specific order into an editing command to occur when annotating the document.

In addition, Ericson et al, Kuruoglu et al, and Lortz fail to specifically disclose determining an authorization level for the at least one editing command, and if the authorization level for the at least one editing command is below an authorization threshold, converting the at least one editing command into an annotation. However, Anderson et al discloses a system that examines a security level of the redaction, a form of annotation, and compares it to the security level of the user in which if the security level exceeds that of the user, then the user is unauthorized to view the document prior to redaction, while, on the other hand, does not exceed the security level, then redaction is not applied. (Column 5, lines 3-14)

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have combined Ericson et al, Kuruoglu et al, and Lortz's method with Anderson et al method with editing commands instead of a user since Anderson et al's method would have allowed documents containing text, graphics, and images to be annotated or redacted by other objects carried in the same data stream without compromising the integrity of the original document.

As per dependent Claim 19, the applicant recites a system for performing the method of Claim 8. Therefore, Claim 19 is similarly rejected under Kardach, Ericson et al, and Anderson et al.

As per dependent Claim 20, the applicant recites a system for performing the method of Claim 10. Therefore, Claim 20 is similarly rejected under Kardach, Ericson et al, and Anderson et al.

7.   Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable Ericson et al (PG Pub 2002/0054778, filed 5/9/2002) in further view of Kuruoglu et al (PG Pub 20020078088, published 6/20/2002) in further view of Lortz (US PGPub 2002/0169986, published 11/14/2002) in further view of Kardach (US PG Pub 20030001020, filed 6/27/2001).

As per dependent Claim 11, Claim 11 discloses similar limitations recited as in Claim 1, and is rejected under rationale. Furthermore, Ericson et al fails to specifically discloses the associating the original electronic version of the document with digital paper further comprises scanning a digital pattern on each copy of the digital paper before printing a plurality of hardcopies and associating the plurality of hardcopies with the original electronic version of the document in a many to one association. However, Paragraph 0034, Kardach discloses using a pen to draws a line over an ID icon that reads the ID pattern, and paper pattern wherein having the ID pattern location be associated with the printed application, while paper pattern be associated with a blank page function. When the pen recognizes a pen stroke between the two patterns, the

paper pattern is associated with the meaning assigned it via by the ID pattern. Thus,

when the paper application is printed, the computer will have stored paper pattern

information associated with the functions to be performed. Kardach discloses scanning

a digital pattern on each copy of the digital paper. In addition, since each hardcopy

printed out contains the same content of information of the original electronic document,

then all the hardcopies are associated with the electronic document based on the same

content.

It would have been obvious to one of ordinary skill in the art at the time of

applicant's invention to have combined Ericson et al, Kuruoglu et al, and Lortz's method

with Kardach's method since Kardach's method would have provided the benefit

associating the printed paper with the application that printed information on the paper.

8.   Claim 12 are rejected under 35 U.S.C. 103(a) as being unpatentable Ericson et

al (PG Pub 2002/0054778, filed 5/9/2002) in further view of Kuruoglu et al (PG Pub

20020078088, published 6/20/2002) in further view of Lortz (US PGPub 2002/0169986,

published 11/14/2002) in further view of Burgess (US PG Pub 20010051890, published

12/13/2001).

As per dependent Claim 12, Ericson et al fail to disclose comparing the

annotation time metadata against a reviewer profile. However, Kuruoglu discloses that

users work collaboratively on a document through a collaborative annotation system

comprising a server communicating with a plurality of workstations. (Abstract, lines 1-7)

It was well-known to one of ordinary skill that a network contained a database consisting

of user profiles allowing only those users listed to be able to login into the corresponding system. When users logged in into a workstation, its time of entry, time of usage, i.e. edits, annotations, or operations performed, and time of logging out is transmitted and recorded in the profile within the database. Thus, Kuruoglu et al discloses annotation objects containing time metadata (Paragraph 0032) wherein the administrator of the collaborative system has the ability to compare the time metadata against the information in the user's profile within the system's database.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have combined Ericson et al's method with Kuruoglu et al method since Kuruoglu et al's method would have allowed the annotations to be independently manipulated by being separated into objects.

In addition, Ericson et al, Kuruoglu et al, and Lortz, fail disclose the reviewer profile includes relative and/or absolute expected annotation time data. However, Burgess discloses task information regarding the expected hours from start to finish of a given task to be completed. (Paragraph 0086)

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have combined Ericson et al, Kuruoglu et al, and Lortz's method with Burgess' method since Burgess' method would have provided the benefit of providing information of a worker's expected time that can be used to compared with the actual date that can result in future benefits of a worker's status.

Response to Arguments

9.   Applicant's arguments with respect to claims 1-21 have been considered but are

moot in view of the new ground(s) of rejection.

Arguments address regarding of the new limitations of Claims 1, 7, 9-13, and 20

brought forth in the amendment in regards receiving a plurality of annotations from a

plurality of team members, receiving annotation author identification data, and obtaining

hierarchal permission data has been viewed the new ground of rejection of 35 USC

103(a) under new references using Lortz, and Burgress.

Conclusion

10.   Applicant's amendment necessitated the new ground(s) of rejection presented in

this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37

CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Faber whose telephone number is 571-272-2751. The examiner can normally be reached on M-F from 8am to 430pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong, can be reached on 571-272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David Faber
Patient Examiner
AU 2178

STEPHEN HONG
SUPERVISORY PATENT EXAMINER